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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,093	03/24/2004	Quintin T. Phillips	10007395-3	7655
7590	11/23/2004		EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration P. O. Box 272400 Fort Collins, CO 80527-2400			MOUTTET, BLAISE L	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/809,093	PHILLIPS, QUINTIN T.
Examiner	Art Unit	
Blaise L Mouttet	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 01 October 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10, 20-22, 25-48 and 53-61 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 5-10, 34-48 and 53-61 is/are withdrawn from consideration.
- 5) Claim(s) 3, 4, 20-22 and 25-33 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

This application is in condition for allowance except for the following formal matters.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

***Election/Restrictions***

Newly submitted or amended claims 1, 2, 5-10, 34-48 and 53-61 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

Claims 1, 2, 5-10, 46-48, 58 and 59 are directed to a method of maintaining a printing cartridge, method of making a printing cartridge or a printing cartridge including a controller disposed on the printing cartridge as disclosed in relation to the embodiment of figure 4 of applicant's disclosure. These claims lack the step of a determination of a remaining useful life of the cartridge by comparing printing history of the cartridge with a threshold as in allowable claims 3, 4, 20-22 or 25-33 (which in turn lack the limitation of the controller disposed on the cartridge).

Claims 34-41, 43-45, 53, 54, 57, 60 and 61 are directed to a method of refilling a printing cartridge, printing cartridge or refilling system including replenishment of different kinds of consumable substances dependent on the usage information or history data as explained in view of the embodiment of figure 1 of applicant's disclosure. These claims lack the step of a determination of a remaining useful life of the cartridge by comparing printing history of the cartridge with a threshold as in allowable claims 3,

4, 20-22 or 25-33 (which in turn lack the limitations related to different kinds of consumable substances).

Claims 42, 55 and 56 are directed to a printing cartridge refilling apparatus including a database of information about different printing cartridges as explained in view of the embodiment of figure 11 of applicant's disclosure. These claims lack the step of a determination of a remaining useful life of the cartridge by comparing printing history of the cartridge with a threshold as in allowable claims 3, 4, 20-22 or 25-33 (which in turn lack the limitations related to a database of information about different cartridges).

These three groups of claims are each seen to be properly distinct species of applicant's disclosed invention from claims 3, 4, 20-22 or 25-33 since they each containing distinct subject matter as explained above and are considered non-obvious over one another. See MPEP 808 and 821.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1, 2, 5-10, 34-48 and 53-61 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

A telephone call was made to applicant's representative on October 28, 2004 to request cancellation of the non-elected claims but a formal notification of election by original presentation was requested.

Applicant is given TWO MONTHS from the date of this letter to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

***Terminal Disclaimer***

The terminal disclaimer filed on October 01, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent 6,789,864, has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Allowable Subject Matter***

The terminal disclaimer filed October 01, 2004 has overcome the non-statutory double patenting rejection of claims 3, 4, 20-22 and 25-33. These claims stand allowable.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Blaise Mouttet who may be reached at telephone number (571) 272-2150. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier, Art Unit 2853, can be reached at (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Blaise Mouttet November 1, 2004

Blaise Mouttet 11/01/2004

LAMSON NGUYEN  
PRIMARY EXAMINER

11/13/04